

## **REMARKS/ARGUMENTS**

### **Amendments**

Before this Amendment, claims 1-21 were present for examination. Claim 21 is amended by this paper. No claims are added or canceled. Therefore, claims 1-21 are present for examination, and claims 1 and 12 are the independent claims. No new matter is added by these amendments. Applicants respectfully request reconsideration of this application as amended.

### **Rejection Under 35 U.S.C. § 112, Second Paragraph**

The Office Action has rejected claim 21 under 35 U.S.C. §112, second paragraph as being allegedly indefinite for failing to particularly point out and claim the subject matter which Applicants claim as the invention. Specifically, the Office Action suggests that it is unclear what structure is further limited by the claim language. Claim 21 has been amended to indicate that *instructions for receiving a specification of the criteria from the merchant party* are included in the *computer readable program*. Applicants believe the rejection to be overcome and respectfully request that it be withdrawn.

### **Rejection under 35 U.S.C. § 103(a)**

The Office Action has rejected claims 1-21 under 35 U.S.C. §103(a) as being allegedly unpatentable over the cited portions of Fortenberry et al., U.S. Patent 6,336,098 ("Fortenberry") in view of the cited portions of Fajkowski, U.S. Patent 5,905,246 ("Fajkowski"). Applicants respectfully traverse because the cited references, even in combination, do not teach or suggest all of the limitations of Applicants' claims.

### **Claims 1-11**

Claim 1 recites in part

*maintaining discount-arrangement information relating to a plurality of discount arrangements, wherein each such discount arrangement is associated with one of a plurality of merchants;*

*receiving transaction information related to a transaction at a point of sale,  
the transaction information identifying a merchant party to the  
transaction;  
receiving an identifier for a discount instrument presented at the point of sale  
during the transaction;  
making a determination whether the merchant party is one of the plurality  
of merchants; and  
returning validation information to the point of sale in accordance with the  
determination.*

At least the elements of claim 1 highlighted above are missing from the combination of Fortenberry and Fajkowski.

As is explained in Applicants' specification, the invention relates to discount instruments of the kind often (but not always) used for fundraising. This kind of discount instrument entitles a consumer to discounts or special offers at a variety of participating merchants. The discount arrangements may differ between merchants. For example, one participating merchant may provide a "buy one, get one free" arrangement to holders of the discount instrument, another merchant may provide a percentage discount on a purchase, and another may offer a free item or product. *See specification paragraphs [0002]-[0004] and [0022].* In the language of the claim, such a discount instrument relates to a *plurality of discount arrangements, wherein each such discount arrangement is associated with one of a plurality of merchants.* In other words, the discount instrument offers discounts at several different merchants, but each merchant defines what discount is available at that merchant. Each discount arrangement (the benefit received by using the discount instrument) is associated with a particular merchant.

By contrast, Fortenberry describes a method for handling electronic coupons. In this arrangement, a manufacturer issues a number of electronic coupons for a particular product. Each coupon is in the form of an electronic file. When a consumer wishes to redeem one of these coupons, the consumer selects a participating merchant and applies the coupon during an online purchase. *See Fortenberry column 3 lines 38 through column 4 line 15, column 5 lines 44-57, and column 7 lines 6-27.* If the coupon is redeemable at multiple merchants, the benefit received upon redemption is the same regardless of which merchant is involved in a transaction.

In other words, the discount arrangement is associated with the product, not with any particular merchant.

Similarly, Fajkowski describes a method and apparatus for coupon management and redemption. In the system of Fajkowski, an “integrated coupon card” stores information scanned from multiple source coupons. *See Fajkowski Abstract*. This system facilitates the management of standard coupons, which are issued by a manufacturer and redeemable at nearly any merchant selling the manufacturer’s product. As such, these coupons are also associated with a product, and not with one of a plurality of merchants.

In support of the rejection, the Office Action cites column 6 lines 58-65 and column 7 lines 10-19 of Fortenberry as teaching or suggesting this element. The Office Action explains that the “coupons can be defined as being redeemable with selected merchants.” *Paper 20071001 page 3*. Applicants respectfully submit that the cited passages do not support the rejection. Even though a coupon as described in Fortenberry may be redeemable at selected merchants, its *discount arrangement* (the benefit to be received by using the coupon) is associated with the product, and not any particular merchant.

Because Fortenberry and Fajkowski contemplate manufacturer coupons that ultimately are honored by the manufacturer and not a retailer, there is no need in either of their systems to verify that a retailer is a merchant with which a discount arrangement is associated. As such neither Fortenberry nor Fajkowski teaches or suggests

*making a determination whether the merchant party is one of the plurality of merchants; and  
returning validation information to the point of sale in accordance with the determination.*

In support of the rejection, the Office Action cites column 2 lines 53-60 and column 6 lines 1-20 of Fortenberry as teaching or suggesting this element. The Office Action explains that “[r]edemption includes presenting the coupon and verifying that the coupon parameters/restrictions (proper product identifier, proper merchant identifier) are met.” *Paper 20071001 page 3*. Applicants respectfully submit that the cited passages do not support the rejection. While the cited passages do indicate that some merchant identification information

may be collected during redemption, there is no suggestion that any test is performed to determine whether the merchant party is a merchant with which a discount arrangement is associated, and there is no suggestion of *returning validation information to a point of sale in accordance with the determination*. In fact, Fortenberry suggests that merchant identification information is collected for “fraud prevention”, for example “to link each coupon redemption to a specific sale of the product to a customer”, or the information may be collected for “statistical marketing analysis reasons”. See *Fortenberry column 5 line 58 through column 6 line 1*. Fortenberry makes no suggestion that a coupon may be redeemed at an improper merchant, and in fact suggests that the coupons can only be redeemed from web sites previously enabled for redemption. See *Fortenberry column 5 lines 44-51 and column 7 lines 17-20*.

Because Fortenberry and Fajkowski, even in combination, do not teach or suggest all of the limitations of Applicants’ claim 1, claim 1 is believed allowable over Fortenberry and Fajkowski. Claims 2-11 depend from claim 1 and add further limitations, and are therefore also believed allowable for at least this reason.

Furthermore, at least claims 2-6 recite further limitations relating to the determination that a merchant is one of the merchants with which a discount arrangement is associated, or relating to the validation information returned to the point of sale. Because neither Fortenberry nor Fajkowski teaches or suggests validating merchants, neither can they teach or suggest the limitations of claims 2-6.

Claims 12-21

Claims 12-21 are apparatus claims claiming a computer system configured with instructions for performing steps similar to the steps recited in claim 1. As is explained above with respect to claim 1, several of these steps are not taught or suggested by Fortenberry or Fajkowski or their combination. Namely, the cited references do not teach or suggest at least these elements of claim 12:

*instructions for maintaining on the storage device discount-arrangement information relating to a plurality of discount arrangements, wherein each such discount arrangement is associated with one of a plurality of merchants; ...*

*instructions for making a determination with the processor whether the merchant party is one of the plurality of merchants; and instructions for returning validation information to the point of sale with the communications device in accordance with the determination.*

Because Fortenberry and Fajkowski, even in combination, do not teach or suggest all of the limitations of Applicants' claim 12, claim 12 is believed allowable over Fortenberry and Fajkowski. Claims 13-21 depend from claim 12 and add further limitations, and are therefore also believed allowable for at least this reason.


Furthermore, at least claims 13-17 recite further limitations relating to the determination that a merchant is one of the merchants with which a discount arrangement is associated, or relating to the validation information returned to the point of sale. Because neither Fortenberry nor Fajkowski teaches or suggests validating merchants, neither can they teach or suggest the limitations of claims 13-17.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
David W. Boyd  
Reg. No. 50,335

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300  
DWB:klb  
61223678 v1